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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,804	06/12/2001	Chiaki Imaeda	9319S-000223	3726

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HARNES, DICKEY & PIERCE, P.L.C.  
P.O. BOX 828  
BLOOMFIELD HILLS, MI 48303

EXAMINER

CHUNG, DAVID Y

ART UNIT PAPER NUMBER

2871

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/879,804

Applicant(s)

IMAEDA, CHIAKI

Examiner

David Y. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The previous election of species requirement sent on April 23, 2003 has been withdrawn in favor of the restriction requirement set forth below in order to eliminate the confusion from the previous requirement.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 33-37, drawn to a particular method of manufacturing an electro-optical device, classified in class 445, subclass 24.
- II. Claims 1, 2, 4-6, 8, 9, 11-16, 18, 19, 30-32, 41, 44-50, 56 and 59-62, drawn to electro-optical devices with a storing portion for storing an electronic part mounted to the panel substrate, classified in class 349, subclass 149.
- III. Claims 25, 27-29, 38 and 40, drawn to electro-optical devices with an electronic part that is not mounted on the panel substrate, classified in class 362, subclass 26.
- IV. Claims 23, 52, 53, 55, 57 and 57, drawn to electro-optical devices having a storing portion for storing an electronic part not mounted on the panel substrate, classified in class 349, subclass 58.
- V. Claim 51, drawn to an electro-optical device containing elements of inventions II and III.

- VI. Claims 24 and 54, drawn to electro-optical device containing elements of inventions III and IV.
- VII. Claims 42 and 43, drawn to electro-optical device containing elements of inventions II and IV.
- VIII. Claims 3, 7, 10, 17, 20, 21, 22, 26 and 39, drawn to electro-optical device containing elements of inventions II, III and IV.

Inventions II, III, and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each invention discloses a particular element that can be used in an electro-optical device without being in combination with the elements of the other inventions. For example, the storing portions of invention II can be used in an electro-optical device without the light emitting elements of invention III or the storing portions of invention IV.

Inventions V and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention III are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention III are

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subsequently found to be unallowable, the question of rejoinder of inventions V and II must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions V and II are distinct.

Inventions V and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention II are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention II are subsequently found to be unallowable, the question of rejoinder of inventions V and III must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention II do not set forth the details of the subcombination and the subcombination has separate utility, inventions V and III are distinct.

Inventions VI and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention IV are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention IV are subsequently found to be unallowable, the question of rejoinder of inventions VI and III must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VI and III are distinct.

Inventions VI and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention III are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention III are subsequently found to be unallowable, the question of rejoinder of inventions VI and IV must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VI and IV are distinct.

Inventions VII and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention IV are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention IV are subsequently found to be unallowable, the question of rejoinder of inventions VII and II must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VII and II are distinct.

Inventions VII and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention II are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention II are subsequently found to be unallowable, the question of rejoinder of inventions VII and IV

must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VII and IV are distinct.

Inventions VIII and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention IV are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention IV are subsequently found to be unallowable, the question of rejoinder of inventions VIII and V must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and V are distinct.

Inventions VIII and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed



does not require the particulars of the subcombination as the claims of invention V are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention V are subsequently found to be unallowable, the question of rejoinder of inventions VIII and IV must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and IV are distinct.

Inventions VIII and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention VI are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention VI are subsequently found to be unallowable, the question of rejoinder of inventions VIII and II must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and II are distinct.

Inventions VIII and VI are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention II are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention II are subsequently found to be unallowable, the question of rejoinder of inventions VIII and VI must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and VI are distinct.

Inventions VIII and III are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention VII are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention VII are subsequently found to be unallowable, the question of rejoinder of inventions VIII

and III must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and III are distinct.

Inventions VIII and VII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as the claims of invention III are evidence claims that indicate that the combination does not rely upon the specific details of the subcombination for its patentability. If the evidence claims of invention III are subsequently found to be unallowable, the question of rejoinder of inventions VIII and VII must be considered and a letter to the applicant will so state. Therefore, since the combination evidence claims of invention III do not set forth the details of the subcombination and the subcombination has separate utility, inventions VIII and VII are distinct.

Invention I is related to inventions II, III, IV, V, VI, VII, and VIII as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the electro-

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optical devices of inventions II, III, IV, V, VI, VII, and VIII can be made without using the molding method of invention I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

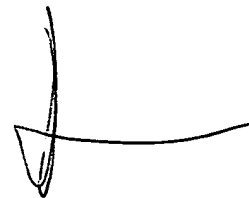
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Chung whose telephone number is (703) 306-0155. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:00 pm.

David Chung  
GAU 2871  
08/25/03



**KENNETH PARKER  
PRIMARY EXAMINER**